

Notice of Allowability

Application No.

10/032,128

Examiner

Jeffrey B. Robertson

Applicant(s)

WOODS ET AL.

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment of 8/27/03.
2. ☒ The allowed claim(s) is/are 1-65.
3. ☒ The drawings filed on 12/21/01 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

(a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- 1 ☒ Notice of References Cited (PTO-892)
- 2 ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3 ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____
- 4 ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
- 5 ☐ Notice of Informal Patent Application (PTO-152)
- 6 ☒ Interview Summary (PTO-413), Paper No. 1103
- 7 ☒ Examiner's Amendment/Comment
- 8 ☒ Examiner's Statement of Reasons for Allowance
- 9 ☐ Other

Jeffrey B. Robertson
Primary Examiner
Art Unit: 1712

EXAMINER'S AMENDMENT

1. Claims 1-12 and 56-65 are directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 49-51, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, are now subject to being rejoined. Claims 13-55 are hereby rejoined and fully examined for patentability under 37 CFR 1.104. It is noted that claims 49-51 indirectly depend from claim 1. Since claims 49-51 also indirectly depend from claim 13, directed to the epoxidized gem-diesters, the examiner has examined all of the previously withdrawn claims.

Since all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, the restriction requirement made in Paper No. 6 is hereby withdrawn.

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Steven E. Reiter on 11/10/03.

The application has been amended as follows: in claim 20, line 2, please delete the "s" at the end of the word "polythiols".

In claim 37, in line 2 of the claim, please delete the word "initiators" and insert the word --promoters-- in its place.

In claim 38, in line 2 of the claim, please delete the word "initiators" and insert the word --promoters-- in its place.

3. The following is an examiner's statement of reasons for allowance: the above amendments were made to the claims in order to overcome a potential claim objection to claim 20, for lack of agreement in number between the article and the noun. For claims 37 and 38, the amendment was made to overcome a potential rejection under 35 U.S.C. § 112 2nd paragraph for lack of antecedent basis in the term polymerization initiators.

Regarding claims 1-12 and new claims 56-65, as discussed by applicant, The Minami ('220) reference and the Nudelman ('995) reference fail to set forth instances of non-aromatic ethylenic unsaturation. Since applicant's claims are limited to this type of unsaturation through the definition given in the specification (page 8, paragraph [0033]), the rejections of the claims using these references have been withdrawn. Regarding the Seo ('327) reference, Seo only teaches methoxy groups that are equivalent to applicant's L group. Since the definition of L including heteroatom-containing hydrocarbyl has been deleted from claim 1, claim 1 is allowed. For claims 56-65, as stated in the previous office action, none of the cited references teach or suggest an n value of 2, which is required by new claim 56.

For claims 18-22, the closest prior art is Seo ('327). Seo does not teach or suggest an adhesive composition containing the gem-diester of the formulas set forth in claim 1.

For claims 13-17, and 23-55, the closest prior art is Widmer et al. (U.S. Patent No. 3,275,661) and Ober et al. (U.S. Patent No. 5,948,922). Widmer teaches the formation of epoxy compounds similar to those claimed by applicant (note col. 2, general formula (IV)). However, the Z group set forth by Widmer does not conform to the backbone set forth by applicant. Indeed, none of the alcohols used to synthesize general formula (IV) set forth in column 4, lines 19-75 contain a two hydroxyl groups off the same carbon atom, which would be required to produce a Z group that corresponds to the backbone set forth by applicant. Ober teaches reworkable cured thermosets similar to those set forth by applicant. However, the epoxy compounds used by Ober do not contain the structure of the geminal diesters set forth by applicant.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schafer et al. (U.S. Patent No. 5,552,070) and Klemarczyk (U.S. Patent No. 6,255,500) are cited for general interest.

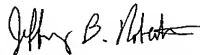
Application/Control Number: 10/032,128
Art Unit: 1712

Page 5

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR